



DOCKET NO.: 275744US6

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF:

GROUP: 2623

Tatsuo KAIZU, et al.

SERIAL NO: 10/039,826

EXAMINER: SHEPARD, J.

FILED: October 23, 2001

FOR: INFORMATION PROCESSING APPARATUS, INFORMATION  
PROCESSING METHOD, AND PROGRAM STORAGE MEDIUM

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

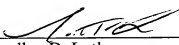
This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney of record.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

  
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Bradley D. Lytle  
Registration No. 40,073

Customer Number

**22850**

Tel. (703) 413-3000  
Fax. (703) 413-2220  
(OSMMN 07/05)

Scott A. McKeown  
Registration No. 42,866



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TATSUO KAIZU, ET AL. : EXAMINER: SHEPARD, J.  
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REMARKS ACCOMPANYING  
PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants respectfully request that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

FAILURE TO PRESENT A PRIMA FACIE CASE OF OBVIOUSNESS

Applicants submit that the Official Action of October 18, 2006 has failed to provide a *prima facie* case of obviousness with respect to Claims 1-8 35 U.S.C. § 103.<sup>1</sup>

Pending Claims 1-5, 7 and 8 stand rejected under 35 U.S.C. § 103 over Levine in view of Heredia. As outlined in detail in the response filed January 16, 2007, this rejection is deficient in that it does not provide any disclosure or suggestion, relative to Heredia, of any feature of modem (20), which enables an automatic download.

<sup>1</sup> See Official Action of October 18, 2006 detailing the rejection of Claims 1-5, 7 and 8 under 35 U.S.C. § 103 based on U.S. Patent No. 5,692,214 to Levine in view of U.S. Patent No. 7,065,287 to Heredia in view of U.S. Patent No. 6,590,503 to Elliot and the rejection of Claim 6 in view of Levine and Heredia in further view of U.S. Patent No. 5,537,473 to Saward.

Heredia describes a system (20) including audio and video subsystems (22, 24). The system (20) cooperatively controls a plurality of A/V components such as speakers, CD changers, television monitors, cable systems, etc. In order to control these components, infrared remote control codes may be obtained from an internal database, or a database on a recording medium, or by downloading from the Internet.<sup>2</sup> To this end, the system (20) includes modem (42) and Ethernet connection (40). For example, the remote control codes may be downloaded from a website such as [www.ueic.com](http://www.ueic.com).

More specifically, Heredia provides:

Infrared remote control codes for the connected components are obtained from an internal database, or a database on a recording medium, or by downloading from the Internet. The Internet connection may be provided by a telephone line connected to modem 42, a local area network via Ethernet connection 40 and external cable modem or satellite connection, etc. Remote control codes available at, e.g., [www.ueic.com](http://www.ueic.com) may be downloaded on an as needed basis by system 20, or may be distributed on computer-readable media, such as a CD-ROM, or otherwise supplied when component(s) are connected to system 20.<sup>3</sup>

As can be appreciated, there is no disclosure, suggestion or any discussion whatsoever which describes the modem (20) automatically obtaining code information as recited in the Applicants' claims.

Specifically, in the Advisory Action dated February 7, 2007, the explanation was provided that:

The applicant argues that Heredia needs user interaction to download IR codes from a network and therefore the process is not automatic, and therefore does not meet the claim limitation. The cited portion of Heredia discloses that "codes may be downloaded on an as needed basis by system 20." The portion does not mention that the user is involved in this process, and it is interpreted as disclosing a system that automatically

<sup>2</sup> Heredia at column 7, lines 36-43.

<sup>3</sup> Heredia at column 7, lines 39-49.

downloads codes without user interaction. The rejection stands.<sup>4</sup> (emphasis added)

As noted above, the Advisory Action of February 7, 2007 provides no such analysis or discussion with respect to the actual teachings of Heredia in support of its rejection. In this regard it is noted that the patent office has the initial duty of supplying the factual basis for its rejection. It may not because it doubts the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). Indeed, the Advisory Action attempts to prove its leap in logic by discussing what Heredia does not describe instead of discussing what Heredia describes. There is no disclosure in Heredia which explains how the modem (20) could determine desired functionality and automatically download codes via the Internet as speculated in the Official Action.

As such, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request that the rejection of Claims 1-5, 7 and 8 under 35 U.S.C. §103 be withdrawn and prosecution be opened in view of the clear factual deficiencies outlined above.<sup>5</sup>

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<sup>4</sup> See Advisory Action of July 18, 2006, at page 2.

<sup>5</sup> Applicants submit that the rejection of Claim 6 under 35 U.S.C. §103 over Levine, Heredia and in further view of Saward is likewise deficient for the reasons stated herein.

CONCLUSION

As the Office has failed to establish a *prima facie* case of obviousness in view of the clear factual and legal deficiencies outlined above, Applicants respectfully request that the prosecution be reopened.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Customer Number

**22850**

Tel: (703) 413-3000

Fax: (703) 413 -2220

(OSMMN 06/04)

SAM/ys



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Bradley D. Lytle  
Attorney of Record  
Registration No. 40,073

Scott A. McKeown  
Registration No. 42,866